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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/803,814	03/17/2004	Kenneth Algine	020375-048200US	5909

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EXAMINER

HESS, DANIEL A

ART UNIT PAPER NUMBER

2876

DATE MAILED: 10/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/803,814	Applicant(s) ALGIENE, KENNETH	
	Examiner Daniel A. Hess	Art Unit 2876	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 July 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4,5,9-15,17 and 22-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4,5,9-15,17 and 22-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This action is in response to 7/11/2005 response and amendment by the applicant, which has been entered into the file of record.

Remarks / Response to Arguments

Firstly, the examiner apologizes for failing to address claims 22-30, which had been added by preliminary amendment prior to initial examination. As a result of the examiner's oversight, the instant action will not be a final action.

Secondly, regarding the included limitation, "wherein the card carrier is constructed so that its identifying element is physically altered when the data card is removed" the examiner considers this limitation to be overly broad. The examiner unfortunately failed to give this claim its broadest interpretation in the art.

Typically, a cashier will not return the packaging to the customer after the cashier activates a card. Suppose the cashier crumples and discards the carrier after registration. Then the carrier, including identifying element, are physically altered when the card is removed.

Also, the term 'physically altered' can be given a very broad interpretation. A magnetic stripe is very slightly physically altered every time it is swiped. The claims give no detail as to what is actually happening during card removal from the carrier.

The examiner notes that the applicant has laid out in the Instant Specification in detail how the identifying element is physically altered. Paragraph [0025] lays out in detail a process involving adhesive tape wherein the carrier information is altered. But the arrangement that produces the alteration is not conveyed in the claim language. The examiner suggests that including limitations describing these systems which cause the alteration could overcome the present rejection.

Claim Objections

Claims 1, 2, 22, 31 and 32 are objected to because of the following informalities: These claims generally have more than one different piece of data named 'identifying element' or 'account identifier.' This could lead one to get them confused. They should be named differently or at least distinguished by label such as 'first identifying element' and 'second identifying element.' Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1, 2, 4, 5, 9, 11-15, 17, 22-24 and 31-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kistner et al. (US 6,543,809).

Re claim 1:

Re claim 1:

A listing of the claim limitations is given below in italics, followed by a discussion.

A data card display system, comprising:

a data card having an identifying element thereon associated with a debit account in order to electronically identify the account and conduct transactions against the account; and

See particularly figures 1, 2 and 3 of Kistner et al. (US 6,543,809). There is a data card 14 attached to carrier 12. The data card 14 has (column 2, lines 66-67) personal identifying indicia 18 correlated with a prepaid account. The fact that the card is prepaid places it in the category of debit cards. That the identifier electronically identifies the account can be accepted as a fact of modern accounting, since at the time of the invention, all such numerically identified cards are related to a corresponding account record in an (electronic) computer.

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a card carrier for holding the data card for display, the card carrier having an identifying element associated with the account in order to electronically identify the account and activate the account for use by the cardholder

The card carrier 12 includes on it activation indicia 26 (see figures 1-3; column 3, lines 39-42).

Since this is activation indicia, it is clearly understood that this indicia is a necessary prerequisite for using the account, such that the indicia must be entered prior to activation of the account.

wherein the card carrier is constructed so that its identifying element is physically altered when the card is removed

Kistner fails to explicitly teach this limitation.

However, typically, a cashier will not return the packaging to the customer after the cashier activates a card. Instead they will discard it. In the process of discarding, it would be typical for the cashier to crumples (or cuts or shreds) and discards the carrier after registration. Then the carrier, including identifying element, are physically altered when the card is removed.

A cashier would have been motivated to crumple/cut and discard the carrier both to save space in a trash receptacle and for security purposes.

Re claim 2:

The display system as in claim 1, wherein the data card is selected from the group consisting of a debit card, stored value card, gift card or credit card, wherein the data card is to be removed from the card carrier after activated, and wherein the card carrier

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is arranged to have its identifying element electronically read prior to removal of the data card.

As discussed re claim 1 above, Kistner et al.'s card is a prepaid card. This is a stored value card, and also a debit card, since a balance is debited with each use. The detachability of the portions 12 and 14 is discussed in the abstract and throughout the document, and can be seen especially in figure 2. Carrier identifying element 26 is clearly to be read prior during activation, and this certainly could take place prior to detachment, since the identifying element 26 is clearly scannable (see figure 1) with the card 14 still in place.

Re claim 4: As should be clear from the discussion of claim 1 above, the card carrier contains activation data while the card 14 contains different data, namely the card account number itself.

Re claim 5: This claim is rejected for the same reasons as claim 1, above. A difference is that the present claim uses the word 'presentation instrument' rather than data card. It is clear to one of ordinary skill in the art that a data card is a presentation instrument.

Re claim 9: In Kistner et al., the presentation instrument is a card, as figures 1-3 all show.

Re claims 11 and 12: It is reasonable for the cashier to cut up or shred any activation stripe after it is used, the motivation being for security. In fact the claim does not recite how the alteration process works.

Re claim 13: The carrier indicia can be magnetic (see column 2, lines 25-35). Regarding distinguishing whether the data is associated with the card or the card, it has already been discussed re claims 4 and 6 that the data is distinguished.

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Re claim 14: The examiner has looked at the paragraph in the specification, paragraph [0025], where this limitation is taught. The specification clearly states that those two pieces of information could be the same (as opposed to have to be the same). This is a clear indication that it is not critical that these pieces of information. As further evidence of the non-criticality, the very next claim, claim 15, claims the very opposite, that the information on each is different.

Re claim 15: See discussion re claim 4, above.

Re claim 17: The carrier does indeed contain account activation indicia.

Re claim 22-24: These limitations are taught in Kistner, which has been discussed above.

Re claims 31-35: These limitations have generally been taught / discussed above.

Claim 10, 25-30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kistner et al. as modified by Risafi et al. (US 6,473,500). The teachings of Kistner et al. as applied to claim 1 have been discussed above.

Kistner et al. teaches a prepaid card. It is not explicitly taught that the card is a gift card.

It is well known that many prepaid cards are gift cards. Risafi et al. (US 6,473,500) (see column 18, lines 43-65) is a notable example.

In view of well known art exemplified by Risafi et al., it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the old and well-known prepaid card of Kistner et al. a gift card.

Re claims 26, 30: If the carrier contains the account number, then certainly the carrier could be used to add value to a card. Generally all one would need to add value to a card is the account number.

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Re claim 27: Kistner shows (see figure 2, ref. 16) this perforation.

Re claim 28: Kistner's card and carrier appear to be made of plastic. In any event, plastic is an ordinary and typical material for credit cards.

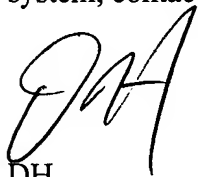
Re claim 29: A retail location is exactly where Kistner's card and carrier is intended to be located.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel A. Hess whose telephone number is (571) 272-2392. The examiner can normally be reached on 8:00 AM - 5:00 PM M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



DH
9/30/05

**DANIEL STCYR
PRIMARY EXAMINER**

